

REMARKS

Claims 1-3, 6, 9 and 18-43 are pending. Claims 1-3 have been amended and new claim 43 has been added. No new matter has been added by way of the present amendments. For instance, claims 1-3 have simply been amended to remove one member, in particular "halogen", from the possible substituents of R¹-R⁵. Additionally, new claim 43 is supported by originally filed claim 1 as well as the present specification at page 22, line 5. Accordingly, no new matter has been added.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. 103(a)

The Examiner has rejected claims 1-3, 6 and 9 under 35 U.S.C. 103(a) as being obvious over JP 11-228491 (hereinafter referred to as JP '491) in view of Ishihara et al., Science, Volume 290 (November 10, 2000) (hereinafter referred to as Ishihara). Applicants respectfully traverse this rejection.

All previously submitted arguments are hereby incorporated. Regardless, Applicants submit that no *prima facie* case of obviousness exists. The primary reference of JP '491 utilizes a fluoro-substituted cyclopropanecarboxylic acid as an intermediate.

However, a review of the rejected claims of 1-3, 6 and 9 reveals that no halogenated cyclopropanecarboxylic acid intermediate (for instance, according to formula (2) of the present invention) is used in the preparation of the present cyclopropanecarboxylate according to formula (1).

Furthermore, no motivation exists to modify the intermediate of the primary reference of JP '491 to arrive at any of the other recited carboxylic acids used as intermediates according to formula (2) of the present invention. That is, neither JP '491 nor Ishihara provide motivation to modify the intermediate of JP '491 and thereby arrive at any of the currently recited carboxylic acids according to formula (2) of the present invention. Homologous intermediates of the prior art which would not obviously have properties in common with the claimed compounds does not render the latter obvious if there is no motivation to interrupt the prior art synthesis to determine the properties possessed by the intermediates. In re Lalu et al. 223 U.S.P.Q. 1257 (Fed. Cir. 1984). Therefore, no *prima facie* case of obviousness exists.

In summary, both of JP '491 and Ishihara fail to suggest or disclose to one of ordinary skill in the art to combine the teachings of the two documents and arrive the presently claimed subject matter. Accordingly, the process according to the present claims is not obvious over JP '491 in view of Ishihara.

Reconsideration and withdrawal of all rejections are therefore requested. All pending claims are thus allowable.

Request for Initialed Form PTO-1449

On September 30, 2003, Applicants filed an Information Disclosure Statement (IDS) with an attached Form PTO-1449. However, the Examiner has not yet returned an initialed version of this Form PTO-1449 indicating that the cited references have been considered. Accordingly, the Examiner is now requested to return an initialed copy of this September 30, 2003 Form PTO-1449.

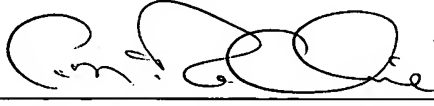
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Craig McRobbie (Reg. No. 42,874) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #42.874
for Raymond C. Stewart, #21,066

RCS/CAM:mmi
2185-0613P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000